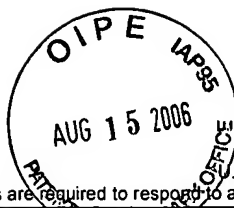


Doc Code: AP.PRE.REQ



PTO/SB/SS (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
81230.96US1

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on August 10, 2006

Signature Ranni Matar

Typed or printed
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Application Number

10/665,643

Filed

09/19/2003

First Named Inventor
Jeffrey J. Young

Art Unit

2612

Examiner

Yacob, Sisay

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

X

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 35,906

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Gary R. Jarosik

Typed or printed name

(312) 456-8449

Telephone number

August 10, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR PRE-APPEAL REVIEW REQUEST

In the application claims 1-26 remain pending.

Pending claims 1 and 13 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chung (U.S. Published Application No. 2002/0077155) as modified by Soini (U.S. Patent No. 6,611,693).

Pending claims 2-4 and 14-16 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chung as modified by Soini as further modified by Dudek (U.S. Patent No. 5,523,800).

Pending claims 5-12 and 17-26 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Chung as modified by Soini as further modified Dudek as still further modified by Mulla (U.S. Published Application No. 2002/0162891).

The reconsideration of the rejections of the claims is respectfully requested.

In the rejection of the claims it was asserted that Chung discloses, as a base point, a method or computer-readable media “which measures a size of a writeable memory measured by a diagnostic routine.” More particularly, it was asserted that Fig. 4 of Chung “clearly show that the size writeable memory is indicated graphically” and Fig. 5 of Chung “clearly shows that the routine that is run to indicate the writeable memory.”

In response it is respectfully submitted that, when the figures and paragraphs of Chung relied upon in the rejection of the claims are carefully considered, it is evident that Chung simply fails to disclose, teach, or suggest these base elements of the invention claimed as asserted.

Considering paragraphs 0033-0035 and Figs. 4 and 5 of Chung, it is respectfully noted that none of the claimed elements are disclosed, taught, suggested, or even alluded

to by Chung therein. As clearly seen below, cited to paragraphs 0033-0035 of Chung, which describe exactly what is illustrated in Figs. 4 and 5, describe nothing more than a method for placing information into available memory locations within a phone book stored in a memory of a mobile phone:

[0033] The same memory space assigning method described above holds true for other memory fields. Hence, according to the preferred embodiment, it is not necessary to fill in an assigned memory area, especially when desired information is not available.

[0034] Fig. 4 is a structural diagram illustrating the saved memory area according to the memory saving method depicted in Fig. 3. The shaded portion in Fig. 4 indicates the memory areas, which had been left unused in the related art memory assignment structure of Fig. 2 due to unavailability of data, but which are being efficiently used according to the preferred embodiment of the present invention. Thus, previously unoccupied memory area are converted into usable memory for other data. All vacant memory areas created due to lack of necessary information for inputting to each field can therefore be used.

[0035] Fig. 5 is a flow chart which illustrates a method of how to use a memory area more efficiently according to the preferred embodiment. As shown in Fig. 5, a user first inputs a name of an intended person for storage (step 41). When a name is entered, the search for the prerecorded same name is preferably automatically conducted. A user, however, may also manually check to determine whether there is an index corresponding to the name of the person being entered (step 42).

Thus, when the paragraphs and figures from Chung relied upon in the rejection are carefully considered, it is evident that Fig. 5 of Chung fails to have any disclosure, teaching, or suggestion that is even arguably relevant to measuring memory size (let alone using a diagnostic routine) while it is similarly evident that Fig. 4 of Chung fails to have any disclosure, teaching, or suggestion that is even arguably relevant to presenting an indication of the size of the memory so measured.

While the paragraphs and figures relied upon in the rejection of the claims clearly fail to disclose any of the claimed elements, it is further respectfully submitted that

nothing within the entirety of Chung is particularly relevant to the invention claimed. For example, it is noted *that the words “measure” or “size” fail to appear anywhere within the disclosure of Chung*. Accordingly, nothing from Chung can be read as disclosing, teaching, or suggesting “a method for presenting a size of a writeable memory within a portable electronic device for a remote communication comprising invoking a diagnostic routine within the portable electronic device for a remote communication which measures a size of the writeable memory and using the portable electronic device for a remote communication to present an indication of the size of the writeable memory as measured by the diagnostic routine” as asserted and relied upon in the rejection of the claims. For at least this reason it is submitted that a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

As concerns Soini, it is respectfully submitted that the mere fact that Soini may disclose a mobile device that may function as a remote control and which may further have its flash memory expanded with an add-on module (Col. 6, lines 61+) simply cannot be said to disclose, teach, or suggest modifying Chung to include that which is missing from Chung in the first instance, namely, a method for presenting a size of a writeable memory within a portable electronic device for a remote communication comprising invoking a diagnostic routine within the portable electronic device for a remote communication which measures a size of the writeable memory and using the portable electronic device for a remote communication to present an indication of the size of the writeable memory as measured by the diagnostic routine. Accordingly, the combination of Chung and Soini cannot be said to have the disclosure required to support a *prima facie* case of obviousness and the rejection must be withdrawn.

Turning now to Dudek, while Dudek suggests on page 16, lines 51+ the desirability of using an LED to display battery power status or to indicate operation termination, nothing from Dudek discloses, teaches, or suggests blinking an LED to convey any sort of numerical information let alone information corresponding to anything measured. Furthermore, nothing from Dudek discloses, teaches, or suggest the desirability of using blinks to indicate digits - which fact has been acknowledged in the Office Action. Accordingly, it is respectfully submitted that nothing from Dudek can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have found it desirable to “modify the indicator to represent a variety of measure values” as asserted in the Office Action and, as such, any conclusion that Dudek somehow suggests modifying Chung to arrive at the invention claimed could only have been arrived at by impermissibly using the Applicant’s disclosure as a guide to first modify how the LED of Dudek is used and to then combine the Dudek LED, so modified using the Applicant’s teachings, with Chung. Since it is well settled that such a rejection which relies solely upon the use of “hindsight reasoning” is not sufficient to support a *prima facie* case of obviousness, it is respectfully submitted that the rejections of the claims based upon the combination of Chung, Soini, and Dudek must be withdrawn.

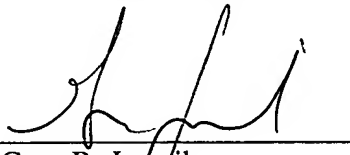
Turning finally to Mulla, while Mulla may disclose emitting a sound, the sound is emitted from the Mulla pen only when it is determined that there is little memory space left. Mulla, however, fails to disclose, teach, or suggest informing the user via the emitted sound how much memory space is left (or overall memory size). Specifically, nothing from Mulla discloses, teaches, or suggests indicating (by sound or otherwise)

anything measured or using one of a plurality of sounds to indicate anything measured. Accordingly, nothing from Mulla can be said to evidence that it would have been “obvious to one skilled in the art use the sound indication to how much memory space is left and/or overall memory size” as asserted in the Office Action. For this reason, it is respectfully submitted that the espoused modification of Chung based upon the disclosure within Mulla also reflects the impermissible use of “hindsight reasoning” and, as such, the rejection of claims 5-12 and 17-26 under 35 U.S.C. § 103 based upon the combination of Chung, Soini, Dudek, and Mulla must be withdrawn for at least the same reason that the rejection of claims 2-4 and 14-16 based upon the combination of Chung, Soini, and Dudek must be withdrawn.

Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Office is respectfully requested.

Date: August 10, 2006

Respectfully Submitted;

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